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In re Application of	:	
Rogers et al.	:	
Application Serial No. 09/776,533	:	PETITION DECISION
Filed: February 7, 2001	:	
Attorney Docket No. MIT 7501-CON	:	

This is a decision by the Group Director of Technology Center 1600 on the petition by facsimile transmission January 16, 2003 to reconsider and review the previous decision of the Group Director of December 18, 2002, that refused to withdraw the final restriction requirement of September 6, 2002.

The petition is **granted to the extent indicated.**

Petitioner notes that while the same claims in the parent application were subjected to a two-way restriction requirement between the claimed composition of matter (claims 13 through17) and claimed methods of using the composition (claims 1 through 12), and were further restricted to an election of species requirement, in the instant application the examiner has imposed a restriction requirement that identifies 24 inventions (12 involving the method claims, and 12 involving the now canceled composition claims.) Petitioner contends that in fact claims 1 through 4, 11, and 12 are generic and that the examiner's inconsistent treatment of the same claims in the involved applications is neither proper nor in accordance with the applicable USPTO procedures regarding restriction. Petition further contends that an election of species requirement is likewise improper herein.

As noted in MPEP 806.01, when as here, questions of restriction are considered; it is the claimed subject matter that must be compared in order to determine the question of distinctness or independence thereof. It is likewise USPTO policy that in order to support a proper requirement for restriction, the examiner must show that the various inventions, as claimed, are either independent, i.e. the inventions are not related, or that the various inventions are distinct, i.e. capable of supporting separate patents. See MPEP 803.

The examiner has maintained that, with respect to the method claims, inventions I through XII are different methods that require the use of patentably distinct ingredients, and as such are patentably distinct. For example, according to the restriction requirement, the Group I invention is drawn to a method of inhibiting stenosis or restenosis with MAC-1 specific antibodies and is asserted to comprise claims 1 through 5, 8, 9, 11, and 12, and the invention of Group II is drawn to a method of inhibiting stenosis or restenosis with MAC-1 specific antibodies and is asserted to comprise claims 1 through 5, 8, 9 11, and 12. Inspection, pursuant to MPEP 814 of all of the 12 supposedly independent or distinct inventions set forth by the examiner, reveals that at least claims 1 through 4, 11 and 12 are common to each of the presumably independent and distinct inventions.

Contrary to the examiner's grouping of the claims for each of the 12 separate inventions, while claims 1 through 4, 11, and 12 may be inclusive of Mac-1 specific antibodies, or LFA-1 specific antibodies, these claims are not specifically limited to the use of either material, or indeed to any of the materials specifically identified in the 12 groups of inventions.

As petitioner correctly urges, since these claims recite the identical invention regardless to which of the 12 groupings of inventions they are allocated, then claims 1 through 4, 11, and 12 cannot be regarded as independent with respect to each other for all of the 12 groups of inventions. Rather, these claims are related since they recite the identical inventions. Furthermore, even though claims 1 through 4, 11 and 12 are related, they cannot be regarded as distinct from each other in each of the 12 groups, since the test for distinctness is whether the allegedly distinct inventions are capable of separate manufacture, use, or sale, and are patentable one over each other as claimed. See MPEP 802.01. Clearly, claims 1 through 4, 11, and 12 in the Group I invention are not capable of separate manufacture, use, or sale, as claimed, and are not patentable, one over each other as claimed in each of the other 11 groups of inventions. Restriction is not proper between these claims in the 12 groups as set forth by the examiner. See MPEP 806(C). Further, where, as here generic or linking claims are present they should not be associated with any one of the linked inventions since these claims must be examined with any one of the linked inventions that may be elected. See MPEP 814, last paragraph.

Even with the examiner's current distribution of claims 1 through 4, 11, and 12, among 12 supposedly distinct inventions, applicant would be prohibited from presenting at least claims 1 through 4, 11, and 12 in any divisional applications. For this reason, appropriate care must be exercised when the independent and distinct inventions are defined by the examiner. Thus, since the restriction requirement as imposed by the examiner and as previously sustained by the Group Director of Technology Center 1600, is premised upon an incorrect grouping and comparison of the claimed subject matter in each of the 12 groups of inventions *vis-à-vis* the issues of independence or distinctness, it will not be permitted to stand.

Petitioner asserts that claims 1 through 4, 11 and 12 constitute generic claims, and points out that the examiner has acknowledged such in the restriction requirement in the parent application. Petitioner seeks reinstitution of an election of species requirement in this application. That fact that at least claims 1 through 4, 11 and 12 are present in each of the 12 groups of inventions set forth by the examiner in this case, and include within their ambit the 12 enumerated materials, coupled with the examiner's assertion that the use of each of the 12 enumerated materials in the method constitutes an independent invention, supports the conclusion that the USPTO restriction practice pertaining to linking claims is more properly applied in this case.

Note that while applicant has asserted that restriction practice relating to genus-species claims, including Markush-type claims, is more proper in the instant application, MPEP 809.03 indicates that there are situations, as here, where linking claim practice is appropriate, including situations where there are generic claims linking species claims. Nevertheless, even if the restriction practice appropriate to linking claims had been applied in this case, applicant would have been required to elected a single invention relating to the use of one of the species claimed as a target (e.g. Mac-1, LFA-1, etc.) even while obtaining an examination of the generic linking claim. Furthermore, an inspection of the record reveals that, at this time, there is no indication that the elected embodiment is patentable. Thus, the linking claims including at least claims 1 through 4, 11, and 12 would not be patentable. ("Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions." MPEP 809.04.) Thus, based upon the current file history regarding patentability, it is neither necessary nor desirable to entirely re-present the restriction requirement, as well as redo the election by applicant, and reinstate the prosecution on the elected embodiment that has already occurred. However, should the elected embodiment ultimately be found allowable and should the linking claims of at least claims 1 through 4, 11 and 12 be similarly be found allowable, then the procedures applicable to linking claim practice as set forth in MPEP 809.03 must thereafter be observed by the examiner.

The next Office Action will recast the restriction requirement in accordance with applicable procedures (as discussed above and outlined below), and will, *inter alia*, specifically withdraw, on the record, the restriction requirement from those claims currently listed as being common to more that one group of independent and distinct invention. Rather, as noted in MPEP 809.03, these claims will not be associated with any group of any independent and distinct inventions. Further, the examiner will identify and examine any linking claims present or indicate, as appropriate, that none are present.

Should there be any questions with regard to this decision, please contact Brian Stanton, by mail addressed to Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-2801 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers

Jasemine C. Chambers
Director, Technology Center 1600

Modified restriction requirement

Restriction to one of each of the following groups of inventions would be required under 35 U.S.C. 121:

Group A

1. Claims 5, 6, and 10, drawn to a method of using MAC-1 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
2. Claims 5 and 9, drawn to a method of using LFA-1 as the target of the compound
3. Claim 5, drawn to a method of using p150,95 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
4. Claim 5, drawn to a method of using CD11d/CD18 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
5. Claims 7 and 9, drawn to a method of using ICAM-1 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
6. Claim 7, drawn to a method of using fibin(ogen) as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
7. Claim 7, drawn to a method of using factor X as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
8. Claim 9, drawn to a method of using ICAM-2 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.
9. Claim 9, drawn to a method of using ICAM-3 as the target of the compound used in the claimed methods of inhibiting or reducing stenosis or restenosis.

Group B

1. Claims 8, drawn to a method of using compounds wherein the compound is an antibody.
2. Claim 8, drawn to a method of using compounds wherein the compound is an expression inhibitor.
3. Claim 8, drawn to a method of using compounds wherein the compound is an expression inhibitor.

Note: This restriction requirement requires that applicant elect a target for the compound used as set forth in Group A in the claimed invention as well as an indication of what type of compound is to be used regarding those recited in claim 8. (Group B). Upon election of the target and compound type, all claims reading on or encompassing said combination of target and compound type will be examined. Note that, e.g., upon election of a method of using MAC-1 (Group A, invention 1), claims 5, 6, and 10 will be examined along with the linking claims set forth below (claims 1 through 4, 11, and 12). Similarly, e.g., upon election of a method of using antibodies (Group B, invention

1), claim 8 will also be examined to the extent that antibodies are the compounds employed. Thus, applicant will receive an examination that takes into consideration the full scope of claims 1-4, 11, and 12, and an examination of claims 5, 6, and 10 to the extent that they read on methods of using MAC-1 as the target and an examination of claim 8 to the extent that it reads on the use of antibodies.

Linking claims

Claims 1 through 4, 11, and 12 link inventions of claim sets A and B. The restriction requirement between the inventions recited in claim sets A and B is subject to the nonallowance of the linking claim(s), claim 1 through 4, 11 and 12. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.